

88



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/737,341	12/15/2000	James C. Colson	157-956	9182

35236 7590 01/03/2005
THE CULBERTSON GROUP, P.C.
1114 LOST CREEK BLVD.
SUITE 420
AUSTIN, TX 78746

EXAMINER

NGUYEN, CAM LINH T

ART UNIT	PAPER NUMBER
----------	--------------

2161

DATE MAILED: 01/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n No.

09/737,341

Applicant(s)

COLSON ET AL.

Examiner

CamLinh Nguyen

Art Unit

2161

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 23-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 23-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. Applicant's amendments to claims 1 – 22 are acknowledged. Consequently claims 1 – 22 are canceled. Claims 23 – 42 are newly added.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 23 – 29, 37 – 42 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological art. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological art fail to promote the “progress of science and the useful arts” (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a method claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

As to technological arts recited in the preamble, mere recitation in the preamble (i.e., intended or field of use) or mere implication of employing a machine or article of manufacture to perform

Art Unit: 2161

some of the recited steps does not confer statutory subject matter to an otherwise abstract idea unless there is positive recitation in the claim as a whole to breathe life and meaning into the preamble. In *Bowman* (Ex parte *Bowman*, 61 USPQ2d 1665, 1671 (BD. Pat. App. & Inter. 2001) (Unpublished), the board affirmed the rejection under U.S.C. 101 as being directed to non-statutory subject matter. Although *Bowman* discloses transforming physical media into a chart and physically plotting a point on said chart, the Board held that the claimed invention is nothing more than an abstract idea, which is not tied to any technological art or environment.

In the present case, although claims 23 – 29, 37 - 42 recite an abstract idea of a method for synchronizing data using a dynamically selected data prioritization scheme, however, the language of the claims raise a question as to whether the claim is directed merely to an abstract idea that is not tied to a technological art, environment or machine which would result in a practical application producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101, which can be implemented by the mind of a person or by the use of a pencil and paper. In another words, since the claimed invention, as a whole, is not within the technological arts as explained above, these claims only constitute an idea and does not apply, involve, use, or advance the technological arts, thus, it is deems to be directed to non-statutory subject matter.

4. To expedite a complete examination of the instant application the claims rejected under 35 U.S.C. 101 (nonstatutory) above are further rejected as set forth below in anticipation of application amending these claims to place them within the four statutory categories of invention.

Claim Rejections - 35 USC § 103

Art Unit: 2161

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 23 – 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boothby et al (U.S. 6,212,529) in view of Bodnar et al (U.S. 6,295,541).

◆ As per claim 23, 30, 37,

Boothby discloses a synchronization system that allows the user to create filters to be used in the synchronization process (col. 5, lines 14 – 20). The filters are previously created and stored in the database (See col. 7, lines 14 – 17, Boothby). Boothby teaches that:

- “Receiving a synchronization request” see Fig. 5, col. 7, lines 6 – 10, Boothby. A sync session request corresponds to the request that the Network computer send to the server to execute the synchronization process.
 - Applicant defined the “prioritization schema” as a predefined scheme. The “filters” in Boothby also a predefined scheme and is stored in database (See col. 7, lines 14 – 17, Fig. 6, element 42). The “filters” includes the conditional or rule that applied for each record (see Fig. 8 - 9, col. 6, lines 20 – 24, col. 10, lines 65 – col. 11, lines 20, Boothby). Therefore, the “prioritization schema” corresponds to the filters in Boothby.
- “Retrieving schema effecting data necessary in effecting the selected prioritization schema” See claim 1, col. 23, lines 20 – 37, col.11, and lines 24 – 30, Boothby.

Art Unit: 2161

- “Producing a prioritized data set based on the selected prioritization schema” See Fig. 12 – 13 and corresponding text, Boothby.

Boothby, however, does not clearly disclose the determination of synchronization session parameters where the parameters including at least a client device designator and a user identifier. Then selecting a priority scheme based on these parameters.

Bodnar, on the other hand, discloses a method for synchronization between pluralities of data set (see Fig. 2 of Bodnar). Bodnar teaches that the system will check all client accessors such as type module (Fig. 11A, 1002, col. 42, lines 31 – 41, col. 38, lines 60 – 67, Bodnar). A mapping table is used in synchronization processing to store client ID and corresponding records (col. 40, lines 13 – 44). Bodnar also allows user to specify settings such as mapping, choosing records (see col. 7, lines 39 – 50, and col. 17, lines 29 – 34, 63 – 65). Based on these settings, the system will determine the processes actions to be performed (col. 42, lines 41 – 47, Bodnar). Clearly, Bodnar discloses the teaching of using client device and user ID in the synchronization system.

It would have been obvious to one with ordinary skill in the art at the time the invention was made to apply the teaching of Bodnar into the invention of Boothby because the combination would provide more data security so that only a certain user can access only certain data or information.

◆ As per claim 24, 31, Boothby and Bodnar disclose:

- “Completing the synchronization request by applying the prioritized data set to data on the client device” See Fig. 6 – 8, col. 7, lines 10 – 12, Boothby.

◆ As per claim 25, 32, 38, Boothby and Bodnar disclose:

Art Unit: 2161

- “Receiving from a user a user-designated prioritization scheme” see col. 7, lines 39 – 50, and col. 17, lines 29 – 34, 63 – 65 of Bodnar).
 - “Associating the received user-designated prioritization scheme with ... parameters to create a parameter-associated prioritization scheme, and storing the parameter” See Fig. 10, col. 40, lines 13 – 44, Bodnar.
- ◆ As per claim 26 - 27, 33 – 34, 39 – 40, Boothby and Bodnar disclose:
- “Recognizing request characteristics from the synchronization request” Fig. 11A, 1002, col. 42, lines 31 – 41, col. 38, lines 60 – 67, Bodnar. And Fig. 2, 5 of Boothby teach about the determining the request characteristics. When the system starts the synchronization process, it must check for identification for the requesting user, the client device type (col. 5, lines 45 – 62, Boothby). From these characteristics, the database will retrieve the corresponded table or parameters from the storage.
- ◆ As per claim 28, 35, 41, Boothby and Bodnar disclose:
- “Retrieving synchronization session parameters from the synchronization request” See col. 39, lines 1 – 17 of Bodnar.
- ◆ As per claim 29, 36, 42, Boothby and Bodnar disclose:
- “Prioritizing database entries and data within the database entries” See col. 39, lines 14 – 17, Bodnar.

Response to Arguments

7. Applicant's arguments with respect to claims 1- 22 have been considered but are moot in view of the new ground(s) of rejection.

Art Unit: 2161

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CamLinh Nguyen whose telephone number is 703 - (571) 272-4024. The examiner can normally be reached on Monday-Friday.

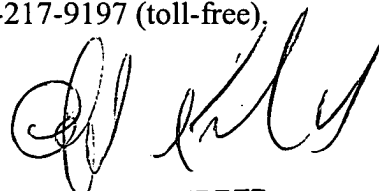
From October 25, 2004, the Examiner can be reached at a new phone number: 571 – 272 – 4024.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on (571) 272-4023. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Cam-Linh Nguyen

Art Unit 2171



**ALFORD KINDRED
PRIMARY EXAMINER**